

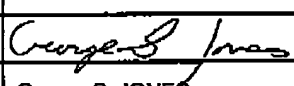
PTO/SB/21 (09-04)

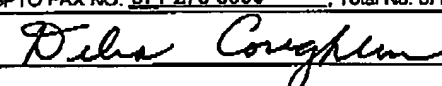
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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/642,468	<b>RECEIVED</b>  <b>CENTRAL FAX CENTER</b>  <b>JAN 05 2006</b>
	Filing Date	August 15, 2003	
	First Named Inventor	Zhuyin (Julie) Li et al.	
	Art Unit	1652	
	Examiner Name	MEAH, Mohammad Y.	
Total Number of Pages in This Submission	11	Attorney Docket Number	USAV2002/0098 US NP

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 5px;">Claim Fee Sheet</div>
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	sanofi-aventis		
Signature			
Printed name	George S. JONES		
Date	January 05, 2006	Reg. No.	38508

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re Application of  
Z. Li et al.

Examiner:

**RECEIVED  
CENTRAL FAX CENTER**

Application No.: 10/642,468

Art Unit:

**JAN 05 2006**

Filed: August 15, 2003

Title: **METHOD FOR ASSAYING  
COMPOUNDS OR AGENTS FOR  
ABILITY TO DECREASE THE  
ACTIVITY OF MICROSOMAL  
PROSTAGLANDIN E SYNTHASE OR  
HEMATOPOIETIC  
PROSTAGLANDIN D SYNTHASE**

TELEFAX CERTIFICATE	
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Date of Transmission	<u>Jan. 5, 2006</u>
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Commissioner for Patents  
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Alexandria, VA 22313-1450

Transmitted herewith is an amendment in the above-identified application.

☐ No additional fee is required.

The fee has been calculated as shown below.

(1)	(2) CLAIMS REMAINING AFTER AMENDMENT*	(3)	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR** / ***	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	32	MINUS	28	4	50.00	200.00
INDEPENDENT CLAIMS	4	MINUS	4	0	200.00	
MULTI-DEPENDENT CLAIMS(S), Per Application (360.00)						0
TOTAL AMENDMENT FEE FOR THIS AMENDMENT						200.00

\* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

\*\* If the "Highest Number Previously Paid For" in Total Claims is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid For" in (Independent Claims is less than 3, write "3" in this space.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. 1.16 which may be required by this paper or credit any overpayment to Account No. 18-1982. Two duplicate copies of this paper are enclosed.

Respectfully submitted,

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Docket No. USAV2002/0098 US NP

RECEIVED  
CENTRAL FAX CENTERIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JAN 05 2006

In re Application of  
Z. Li et al.

Examiner: Meah, Mohammad

Art Unit: 1652

Application No.: 10/642,468

Filed: August 15, 2003

Title: **METHOD FOR ASSAYING COMPOUNDS  
OR AGENTS FOR ABILITY TO  
DECREASE THE ACTIVITY OF  
MICROSOMAL PROSTAGLANDIN E  
SYNTHASE OR HEMATOPOIETIC  
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*Debra Cougle*  
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REPLY TO RESTRICTION REQUIREMENT

Mail Stop Amendment  
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Alexandria, VA 22313-1450

In response to the Office Action mailed December 5, 2005, the shortened period of response set at one-month, Applicants reply to the Restriction Requirement by electing the second Group II with traverse. The Office Action characterized Group II as drawn to screening compounds that decrease activity of PG synthase "comprising SEQ ID NO: 4." Applicants respectfully point out that this characterization of the claim scope is inaccurate and improper. The detection method detects the analyte (PGD<sub>2</sub> and/or PGE<sub>2</sub>) independent of the specific sequence of the enzyme. Any process that changes the PG precursor substrate to the desired PG product is appropriate for the assay method. Notably, only claims 5, 22-26 and 28 recite SEQ ID NO: 4. Thus Applicants respectfully assert that an election of species is more proper than a Requirement for Restriction. Accordingly, to expedite prosecution, Applicants elect as a species SEQ ID NO: 4. Applicants further traverse the Restriction Requirement on the basis that the Office Action further mischaracterizes the invention, for example, at page 2, lines 13-18:

Inventions in group II and I are unrelated. Inventions are unrelated if it can be shown that they are not capable of use together and they have different modes of operation, different functions, or different effects. In the instant case the different inventions, inventions of group I and group II are method steps involving two prostaglandin synthases (with distinct amino acid sequence with different structures and functions) and produce different outcomes.  
(citation omitted).

Clearly inventions in group II and I can be used together and thus are not unrelated. See for example, the specification, page 11, lines 14-21 where "fluorescence label" is discussed. The use of two or more of the various labels (or other selected labels not listed) allows the skilled artisan to monitor multiple compounds with different emission spectra. Thus in a single assay the skilled artisan is able to determine whether a compound or agent modulates activity for as many enzymes as enzymes and labels are present.

While specific synthases may produce specific PGs and the PGs may produce different or distinguishable outcomes, the present invention is not directed to those outcomes. Rather the present invention is directed to e.g., "evaluating the ability of compounds or agents to decrease or inhibit the activity of a prostaglandin synthase". Specification, page 8, lines 16-18. Consequently, the present invention e.g., allows identification of "a compound or agent that may have applications in treating pain, inflammation, fever, or a combination thereof in a subject." Specification, page 8, lines 4-5. Whether the invention is practiced using e.g., a PGD, a PGE synthase or a mixture of synthases, the outcome is the same, identification of candidates for use in mediating synthase activity and thereby modifying an inflammatory, pain or other PGD or PGE mediated response.

Thus the inventions of groups II and I do not relate to recognized divergent subject matter, cannot be said to have acquired a separate status in the art, and clearly cannot be said to be distinct. Accordingly, Applicants respectfully assert that restriction for examination purposes is improper. However, as stated above, Applicants do not traverse this action if interpreted as an election of species requirement and have elected Group II (2d) in this context.

To emphasize the independence of the invention from specific SEQ ID NOs Applicants provide an amended set of claims.

Amended claims begin on page 3.

Accompanying remarks begin on page 9.